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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,351	10/31/2000	Anders Borgstrom	34650-604PT	3222

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JENKENS & GILCHRIST, PC
1445 ROSS AVENUE
SUITE 3200
DALLAS, TX 75202

EXAMINER	
LE, BRIAN Q	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/703,351	BORGSTROM ET AL.	
	Examiner	Art Unit	
	Brian Q Le	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-20,22-26,28-30 and 32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-20, 22-26, 28-30, and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 August 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/24/2004 has been entered.

Response to Amendment and Arguments

2. Applicant's arguments with regard to claims 1, 3-20, 22-26, 28-30 and 32 have been fully considered, but are not considered persuasive because of the following reasons:

Regarding claim 1, the Applicant argues (top of page 7) that Lazzouni does not teach a configuration form including an electronic reading device configuration box. First, this limitation has been considered as new subject matter because there is no support in the original disclosure show the limitation of "the electronic reading device configuration area ... configuration box". In addition, Lazzouni clearly teaches the electronic reading device configuration area (FIG. 12) comprises an electronic reading device configuration form (the configuration form that configures the coordinates of the pen/stylus) and the configuration form includes an electronic reading device configuration box (column 14, lines 13-15).

Referring to claim 13, Applicant's arguments, see page 7, filed 08/24/2004, with respect to the rejection of claim 13 under 35 U.S.C 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Berman U.S. Patent No. 5,710,832.

Referring to claims 24-32, Applicant's arguments, see pages 9-10, filed 08/24/2004, with respect to the rejection(s)of claim(s) 24-32 under 35 U.S.C 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Zank U.S. Patent No. 6,307,955.

Thus, the rejections of all of the claims are maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, and 3-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no clear support in the original disclosure to show the limitation of "the electronic reading device configuration area ... configuration box", the Applicant must clearly indicate the exact location (page number and line number) in the original disclosure for the support of this limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-8, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazzouni U.S. Patent No. 5,652,412.

Regarding claim 1, Lazzouni teaches an electronic reading device (abstract), comprising:

A reading sensor for detecting a portion of an address pattern on a formatted surface (FIG. 9, element 204);

A processor (pre-processor/processor/microprocessor) (FIG. 11, element 264 and column 4, lines 30-40) for identifying the detected portion of the address pattern as being within an electronic reading device configuration area and for converting position data received from the reading sensor into a configuration setting (column 2, lines 60-67); and

Wherein the electronic reading device configuration area (FIG. 12) comprises an electronic reading device configuration form (the configuration form that configures the coordinates of the pen/stylus) and the configuration form includes an electronic reading device configuration box (column 14, lines 13-15).

Referring claim 3, Lazzouni also teaches the electronic reading device further comprising a memory for storing (storing unit) (column 3, lines 27-34) the configuration setting.

Regarding claim 4, Lazzouni teaches the electronic reading device wherein the processor converts the position data into the configuration setting using a configuration application (pen/stylus that reads and transfers the information) (column 4, lines 51-65).

For claim 5, Lazzouni discloses the electronic reading device wherein the position data corresponds to handwritten information written with the electronic reading device, the conversion of the position data into the configuration setting performed using handwriting recognition (column 5, lines 1-12).

Regarding claim 6, Lazzouni teaches the electronic wherein the handwritten information is entered in field of the electronic reading device configuration area that corresponds to the configuration setting (FIG. 4 and FIG. 5A-D).

For claim 7, Lazzouni further discloses the electronic reading device wherein the position data is associated with at least one of a plurality of fields (FIG. 4 and FIG. 5A-D), the processor operating to convert a detection of a portion of the address pattern within the at least one of the fields into a configuration setting corresponding to the at least one field (column 9, lines 1-12 and column 4, lines 30-40).

Regarding claim 8, Lazzouni further teaches the electronic reading device wherein each of the plurality of fields corresponds to a different alphanumeric character (FIG. 1, element 12).

Referring to claim 20, please refer back to claim 1 for the explanation.

Regarding claim 22, please refer back to claim 5 for the explanation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni U.S. Patent No. 5,652,412 as applied to claim 1 above, and further in view of Bi U.S. Patent No. 5,990,875.

Regarding claim 9, Lazzouni is not explicitly teaches an identification code. Bi teaches a pen-based computer system that utilizes identification code (password protection) (FIG. 40a).

Modifying Lazzouni's method of electronic reading device according to Bi would able to provide the security to the configuration. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Lazzouni according to Bi.

For claim 10, Bi futher teaches an address of a server (node address) used for authenticating configuration of the electronic reading device (FIG. 51, element 14002).

Referring to claim 11, Lazzouni teaches the transmitter for transmitting the configuration setting to a support server (host computer) (column 9, lines 15-27).

For claim 12, Lazzouni further teaches the electronic reading device wherein the transmitter transmits information via one of a cable (Ethernet) and a local wireless link (column 9, lines 15-27 and column 3, lines 5-8).

9. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lazzouni U.S. Patent No. 5,652,412 and Berman U.S. Patent No. 5,710,832.

Regarding claim 13, please refer back to claims 1 and 8 for the teaching of discussed limitations. Lazzouni does not explicitly teach the formatted surface includes a plurality of boxes and each of the plurality of boxes corresponds to the at leas one alphanumeric character. Berman teaches a method of processing an electronic device (FIG. 7) comprises the formatted surface includes a plurality of boxes and each of the plurality of boxes corresponds to the at least one alphanumeric character (FIG. 1D-1F, element 107 and column 4, lines 18-35). Modifying Lazzouni's method of electronic reading device according to Berman would able to allow user/operator to enter in alphanumeric letters and help improve the recognition (column 4, lines 30-50). This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Lazzouni according to Berman.

For claim 14, please refer back to claim 7 and 8 for the explanation.

For claim 15, Lazzouni teaches the system further comprising a server for storing the at least one alphanumeric character (column 2, lines 40-67).

10. Claims 16-19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lazzouni U.S. Patent No. 5,652,412 and Berman U.S. Patent No. 5,710,832 as applied to claim 13 above, and further in view of Bi U.S. Patent No. 5,990,875.

Regarding claim 16, Lazzouni does not explicitly teach the comparing of alphanumeric character with a stored identification code. Bi teaches a pen-based computer system that compares alphanumeric character with a stored identification code (password matching) (FIG. 40a, elements 1312 and 1320). Modifying Lazzouni's method of electronic reading device according to Bi would able to further increase the security protection by using password comparison configuration. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Lazzouni according to Bi.

Regarding claim 17, Bi further teaches the use of the electronic reading device when the at least one alphanumeric character matches the stored identification code (FIG. 40a, elements 1320, 1322, and 1314).

Regarding claims 18-19, please refer back to claim 12 for the explanation.

Regarding claims 23, please refer back to claims 13, 16 and 17 for further explanation.

11. Claims 24-26, 28-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lazzouni U.S. Patent No. 5,652,412 and Zank U.S. Patent No. 6,307,955.

Regarding claim 24, Lazzouni teaches a electronic reading device comprising:

A formatted surface having an address pattern (FIG. 4 and FIG. 5A-5D), wherein a position relative to the address pattern can be determined from an examination of a portion of the address pattern (FIG. 9).

An electronic reading device including a reading sensor for detecting portions of the address pattern (column 2, lines 60-67);

A first processor for translating detected portions of the address pattern into a data entry (column 4, lines 30-50).

Lazzouni does not teach the processor for comparing the data entry to a stored user identifier and for enabling the electronic reading device if the data entry corresponds to the stored user identifier. Zank teaches a method of processing an electronic device (abstract, first 5 lines) comprises a processor (FIG. 1, element 12) for comparing the data entry to a stored user identifier and for enabling the electronic reading device if the data entry corresponds to the stored user identifier (a process of signature authentication) (column 6, lines 35-38 and column 7, lines 10-33); and wherein the data entry and the stored user identifier represent a handwritten signature (FIG. 4). Modifying Lazzouni's method of electronic reading device with multiple processors according to Zank would able to further increase the security protection and authentication by using signature/handwriting. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Lazzouni according to Zank.

Regarding claim 25, Lazzouni uses the same processor to perform various means (column 3, lines 51-52). Thus, it would have been obvious to one skilled in the art to apply the

first and the second processor to be the same processor to save cost and utilize the processor more efficiently.

Regarding claim 26, please refer back to claim 5 for the explanation.

Regarding claim 28, please refer back to claim 9 for further explanation.

For claim 29, please refer back to claim 1 and claim 24 for the explanation.

For claim 30, please refer back to claim 5 for the explanation.

For claim 32, please refer back to claim 28 for the explanation.

Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q Le whose telephone number is 703-305-5083. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5397 for regular communications and 703-308-5397 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

BL
September 24, 2004

SAMIR AHMED
PRIMARY EXAMINER